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| EXAMINER |
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BLAU, STEPHEN LUTHER

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| ART UNIT | PAPER NUMBER |
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3711

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| NOTIFICATION DATE | DELIVERY MODE |
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10/29/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 10/598,115 | Applicant(s) OLDENBURG, JOHN E. | |
| | Examiner Stephen L. Blau | Art Unit 3711 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 October 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 1-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-14 and 16-20 is/are rejected.
- 7) ☒ Claim(s) 15 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Request for Continued Examination (RCE)

1. The request filed on 27 July 2009 for a Request for Continued Examination (RCE) under 37 CFR 1.53(d) based on parent Application No. 10/598,115 is acceptable and a RCE has been established. An action on the RCE follows.

Specification

2. The change to the specification is agreed with and the objection to under rule 1.71 of 37 C.F.R. is removed.

Response to Amendment

3. The amendment filed 26 June 2009 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: For claim 13 the Examiner was unable to find in the originally filed application that the family of shafts are substantially the same predetermined length. Keeping the word substantially with respect to length of the shafts the Examiner would consider new matter.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

4. The change to the claims are agreed with and the rejection under 35 U.S.C. 112, first paragraph, is removed.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 13, 16-17 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claims 13 and 16-17 the Examiner does not understand what is being claimed with respect to the inside surface being closer along the taper profile. It seems discussion of a mandrel is being included in these claims without mentioning the mandrel. Claim 20 recites the limitation "the same taper profile" in line 3. There is insufficient antecedent basis for this limitation in the claim. Plus it is uncertain what is meant by "a different portion of the same taper profile".

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 12-14, and 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shigetoh (5,028,464) in view of Wright (4,455,022) or Mann (3,963,236).

Shigetoh discloses a shaft having an outer shell with longitudinal fibers and an inner core of angled fibers (Figs. 4-5).

Shigetoh lacks a family of shafts having substantially the same longitudinal bending stiffness profiles and incremental differences in weights, the core of each shaft having an outside surface that is maintained substantially the same size to maintain the same size shell in each shaft, the family of shafts are substantially the same predetermined length, the incremental differences in weights of the family of shaft being substantially the same from the heaviest of the shafts to the lightest, and cores of the shaft having the same outside size and shape and inside sizes that are reduced in size for each incremental change in weight.

Wright discloses a master shaft cutting small amounts from both the butt end and the tip end to produce shafts of different lengths to produce different shafts for different numbered clubs or different stiffnesses (Col. 2, Lns. 18-25, Col. 3, Lns. 15-31). Mann

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discloses cutting small amounts from a stock shaft from the tip end (1/3 inch between each shaft in a set) to produce shafts of different lengths to produce a set of irons (Fig. 3). In view of Wright or Mann it would have been obvious to include in the shaft of Shigetoh a family of shafts which are made from the same stock or master shaft with the only difference is having a different amounts of a tip end cut off having substantially the same weight in order to provide different lengths to different golfers or in order to provide a set of shaft with different lengths for different clubs in a set. As such the family of shafts would have substantially the same longitudinal bending stiffness profiles and incremental differences in weights in the form the part of the shaft which is the same for each shaft would have the same longitudinal bending stiffness and with different amounts of the tip end cut off there would be weight differences. In addition, the core of each shaft would have an outside surface that is maintained substantially the same size to maintain the same size shell in each shaft in the form of the part of the shaft which is the same for each shaft would have the same diameter for the core. In addition, cores of the shaft having the same outside size and shape in the form of the butt diameter if only the tip ends were cut and the inside sizes would be reduced in size for each incremental change in weight in the form of the inside tip diameter would change as different amounts were cut from the tip end. Also with the small different amounts cut from the tip end of the master shafts the family of shafts would be substantially the same predetermined length.

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9. In alternative, claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shigetoh (5,028,464) in view of Wright (4,455,022) or Mann (3,963,236) as applied to claims 12-13 above, and further in view of Examiner's Official Notice.

Shigetoh lacks the incremental differences in weights of the family of shaft being substantially the same from the heaviest of the shafts to the lightest. The Examiner takes Official Notice that it is well known to produce composite shafts with a cylindrical butt end and tip end. In view of the Examiner's Official Notice it would have been obvious to modify the shaft of Shigetoh to have a cylindrical butt end and tip end in order to have the same uniform feel along the grip for a golfer and in order to have the same outer diameter for a tip end to be placed in a hosel no matter how much is cut off the tip end to produce the correct length for a shaft. As such if 1/3 inch is cut from a master shaft for each shaft in a set the incremental differences in weights of the family of shaft would be substantially the same from the heaviest of the shafts to the lightest.

Allowable Subject Matter

10. The Examiner suggests the following amendment in order to overcome the combination of Shigetoh (5,028,464, (Figs. 4-5)) or Kawmastus (5,421,573, (Fig. 4)) where it is known to have an outer shell with longitudinal fibers and an inner core of angle fibers with references of Wright (4,455,022, (Abstract)) or Mann (3,963,236, (Fig. 1)) where it is known to cut small amounts from the tip end to produce shafts of different lengths. It is the opinion of the Examiner that the longitudinal bending/stiffness profile in

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each shaft family would be substantially the same due to their being significant portions of the shaft having identical designs. These outer shells would have the same size in term of diameters. However adding the structure that the shafts have the same predetermined lengths would overcome these rejections. The Examiner would need to do an updated search but if nothing else is found the Examiner believes this would place the case in condition for allowance.

a. In claim 12 line 12 after the words "the same size shell in each shaft" the words -- wherein the said shafts are of a same predetermined length -- have been added.

b. In claim 13 line 2 the words "are of substantially the same predetermined length have" have been deleted.

c. In claim 13 lines 4-7 the words ", and each lighter shaft of the family of the family taper has an inside surface that is closer along the taper profile to the butt-end portion than the interior surface of the next-heavier shaft, by a distance sufficient to compensate for the difference in the angle-fiber-and-resin material -- have been deleted.

d. Claims 1-11, and 16-20 have been canceled.

Election/Restrictions

11. Claim 15 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. None of the prior art discloses or renders as obvious a family of shafts with the weight differences as claimed in claim 15 in addition to the other elements of structure claimed.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen L. Blau whose telephone number is (571) 272-4406. The examiner can normally be reached on Mon - Fri 10:00 AM - 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene Kim can be reached on (571) 272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Slb/26 October 2009

/Stephen L. Blau/
Primary Examiner, Art Unit 3711